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|---------------|-------------|-----------------------|---------------------|
| 08/657,725 | 05/03/96 | BURTON | 4743 P12 |
| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |

F3M1/0820

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| | |
|-----------------------|--------------|
| CARLSON J EXAMINER | |
| | |
| ART UNIT 01 | PAPER NUMBER |
| 08/20/97 ² | |

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/657,725

Applicant(s)

Burton

Examiner

Jeffrey D. Carlson

Group Art Unit

3301



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) 6 and 7 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 and 8-10 is/are rejected.

☒ Claim(s) 5 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION***Election/Restriction***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

| <u>group</u> | <u>species</u> | <u>claims</u> | <u>figs</u> |
|--------------|----------------|---------------|-------------|
| I | rattle | 1-5, 8-10 | 1-7 |
| II | lamp | 1-4, 7-10 | 1-5, 7, 9 |
| III | scent | 1-4, 6, 8-10 | 1-5, 7, 8 |

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4 and 8-10 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Joseph Coppola on 8/5/97 a provisional election was made without traverse to prosecute the invention of the rattle species, claims 1-5, 8-10. Affirmation of this election must be made by applicant in responding to this Office action. Claims 6 and 7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

3. The use of the trademark Mylar has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

U Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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Claim Objections

4. Claims 3, 5 and 9 are objected to because of the following informalities:

Ⓢ Claim 3, mylar should be replaced by its generic name.

Ⓢ Claim 5 line 2, "element" should be --elements--.

Ⓢ Claim 9, "planer" should be --planar--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by DeJaynes (5130169). DeJaynes teaches a longitudinal central tube member that includes a surrounding sliding collar 22. Attached to the sliding collar 22 are planar ribs 28 which are also attached to the opposite end of the central tube. As the tube is slid downwardly, the ribs flex outwardly. The "light, flexible, ribbon-like" rib material is taken to provide some level of inherent resilience, providing a force that tends to push the collar to the opposite end 16. The ribs are formed integrally from a single sheet member.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeJaynes. It would have been obvious to have selected Mylar as the "light, flexible, ribbon-like" rib material, as this inexpensive material is well known for amusement devices requiring flexible and decorative film. The specific coloration or provision of the central tube as transparent is also taken to have been a design choice; it would have been obvious to have provided the central tube as a clear tube for a particular decorative appearance. Further, there is no demonstration of criticality regarding the clear material. Although the ribs do not appear to be creased, to have done so represents a mere choice of design, providing only a fanciful decorative effect.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeJaynes in view of Donovan et al (CA640801). DeJaynes provides a sliding collar which cannot slide off the end of the central member. It appears that the shoulder of the central tube 12 acts as a stop for the sliding collar. However, it would have been obvious to have provided a slide stop on the central member in a manner as taught by Donovan et al. This would prevent the sliding collar from coming off of the central tube 12.

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10. Claim 3 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over DeJaynes in view of Yedlin et al (5609928). Yedlin et al also teach a central tube member with decorative attached ribs 36. The ribs are formed of flexible plastic sheets which may be metallized [col 3 lines 6-10]. It would have been obvious to have provided metallized plastic (i.e, Mylar) decorative ribs with that of DeJaynes as taught by Yedlin et al.

11. Claim 8 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over DeJaynes in view of Neighbors (4884328). Neighbors provides a similarly formed decorative device with longitudinal ribs that flex outward. Neighbors provides bends (creases) at the midpoint of the ribs. It would have been obvious to have provided such midpoint creases with the ribs of DeJaynes.

Allowable Subject Matter

12. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is (703) 308-3402.



jc

August 15, 1997



ROBERT A. HAVER
S.P.E.
ART UNIT 331